

JAN 03 2008**PATENT**
APPLICATION 10/577,823
ATTORNEY DOCKET 1041-006**REMARKS**

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

The specification has been amended to correct a matter of form and one or more typographical errors. It is respectfully submitted that no new matter has been introduced.

Each of claims 7, 8, 14, 19-22, 29, 30, 35, and 36 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Each of claims 37-44 has been added.

Claims 1-44 are now pending in this application. Each of claims 1, 23, and 36 is in independent form.

I. The Objection to the Abstract

The Abstract was objected to as allegedly not commencing on a separate sheet in accordance with 37 CFR 1.52(b)(4). Included herewith is new Abstract. Applicant respectfully requests cancellation of the previous Abstract. The new Abstract is submitted on a separate sheet. Reconsideration and withdrawal of the objection to the abstract is respectfully requested.

II. The Objection to the Specification

In the Office Action, the Specification was objected to because it does not contain a Brief Summary of the Invention. This objection is respectfully traversed for lack of legal basis.

With all due respect, the MPEP is not the law. Instead, the MPEP merely presents the preferences of the USPTO.

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The legal requirements for the content of a patent application are stated in 35 U.S.C. 111 (“such application shall include... a specification”). The legal requirements for the specification are further defined in 35 U.S.C. 112 (“[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”).

Further details regarding the legal requirements for the specification are provided in 37 CFR 1.71 (“The specification **must** include a written description of the invention or discovery and of the manner and process of making and using the same”; “[t]he specification **must** set forth the precise invention for which a patent is solicited”; [i]n the case of an improvement, the specification **must** particularly point out....”).

The “Summary of the Invention” is mentioned in the statutory law in 37 CFR 1.73, which states that a “brief summary of the invention indicating its nature and substance... **should** precede the detailed description.” The use of the word “should” rather than the word “must” indicates that the Summary section is optional. This interpretation is further supported by the next sentence of 37 CFR 1.73, which states “[s]uch summary should, **when set forth**, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.”

Even the USPTO’s interpretation of the law and statement of its preferences, as provided at MPEP section 608.01(d), admits the optional nature of the Summary section via its statement that “[t]he brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.” This permissibility is echoed at MPEP section 608.01(a), which provides a form paragraph stating “[t]he following order or arrangement is **preferred** in framing the specification.... [i]f no text follows the section heading, the phrase ‘Not Applicable’ should follow the section heading....”

Even the USPTO’s PASAT Authoring Manual, which provides detailed information and instructions on how to author a patent specification for filing electronically, **explicitly states that the Summary section is “optional”**. Thus, a Summary section is not legally required in a patent application.

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Consequently, for at least the reasons mentioned above, it is respectfully submitted that the specification meets all relevant legal requirements, and respectfully requests withdrawal of the objection to the specification.

III. The Statutory Subject Matter Rejections

Each of claims 1-22 and 36 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, and thus was asserted to be unpatentable. Each of these rejections is respectfully traversed. As an initial matter the rejection of claim 36 is traversed as moot in view of the present amendments to claim 36. Claim 36 states, *inter alia*, "machine readable medium storing instructions, executable by an information device". Applicant respectfully submits claim 36 as amended complies at least with MPEP 2106 IV.B.1.a.

A. The Statute

The statute of 35 U.S.C. 101 states, "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

B. Computer Software

The Federal Circuit has held (internal citations omitted), in *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999) (quoting *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998), *cert. denied*, U.S., 119 S. Ct. 851 (1999), that:

"[u]npatentable mathematical algorithms are identifiable by showing they are merely abstract ideas constituting disembodied concepts or truths that are not 'useful' ... [T]o be patentable an algorithm must be applied in a 'useful' way." In that case [referring to *State Street*], the claimed data processing system for implementing a financial management structure satisfied the 101 inquiry because it constituted a "practical application of a mathematical algorithm ... [by] produc[ing] 'a useful, concrete and tangible result.'"

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The Federal Circuit further explained (regarding a standard established in *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994)) in *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999) (internal citations omitted) that:

the Alappat inquiry simply requires an examination of the contested claims to see if the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been reduced to some practical application rendering it "useful." In *Alappat*, we held that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete, and tangible result of a smooth waveform display.

Applicant respectfully submits that the claimed subject matter in both *In re Alappat* and *State Street*, both of which were held to comprise statutory subject matter, were directed toward a machine that achieved certain results. See *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999). Similarly, the claimed subject matter in *AT&T* was held to comprise statutory subject matter since the claimed subject matter resulted in differential billing for long-distance calls. *Id.*

Also of note is a BPAI decision applying the criteria of *State Street Bank* and relating to analogous subject matter to the present application. The claims at issue in this BPAI decision stated, *inter alia*, (emphasis added) "means for receiving from a supplier a candidate or candidates with appended resumes as appropriate; and means for **displaying for the user the supplier responses and associated resumes.**" *Ex parte Parks*, 2004 WL 4979154 (BPAI 2006).

The BPAI found the claims of *Ex Parte Parks* statutory as "certainly useful in matching the skills wanted by a user with the skills of technicians employed by a supplier". The BPAI further commented, "[t]he invention produces a concrete result because a list, or choice, of candidates is provided to the user"

Finally, the relevant case law teaches that an "invention includes 'any new and useful process, machine, manufacture or composition of matter.'" *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005) (citing 35 U.S.C. § 101 (2000)). "Without question, **software code alone qualifies as an invention eligible for patenting** under these categories, at

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least as processes.” *Id.* (citing *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999)).

Claim 1, from which each of claims 2-22 ultimately depends, states, *inter alia*, “a computer-based document management module adapted to create a source document comprising the plurality of objects”. Applicant respectfully submits that claim 1 is analogous to the differential billing provided by the claim in *AT&T* and to the supplier responses and associated resumes found to be directed toward statutory subject matter in *Ex Parte Parks*.

For at least these reasons, reconsideration and withdrawal of each of these rejections is respectfully requested.

IV. Claim Construction

Before *prima facie* criteria for a substantive rejection can be applied, the words of each claim must be interpreted. The Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 546 U.S. 1170, 126 S.Ct. 1332, 164 L.Ed.2d 49 (2006) has clarified that:

1. “[t]he Patent and Trademark Office (‘PTO’) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art’” (*Id.* at 1316);
2. the words of a claim “are generally given their ordinary and customary meaning” (*Id.* at 1312);
3. the ordinary and customary meaning of a claim term is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application” (*Id.* at 1313);
4. “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification” (*Id.*);
5. even “the context in which a term is used in the asserted claim can be highly instructive” (*Id.* at 1314);
6. “the specification may reveal a special definition given to a claim term by the

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- patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor's lexicography governs**" (*Id.* at 1316);
7. even "when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents" (*Id.* at 1321);
 8. an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office" (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
 9. the "prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited during the examination of the patent**" (*Id.* at 1317).

The rules established in *Phillips* apply to *ex parte* examination in the USPTO. *See, In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005).

In the present Application, the customary meaning for the phrase "distribution permission" is explicitly defined in the specification at paragraph 27. That definition must control examination of those claims that contain this phrase. Paragraph 27 states that the phrase "distribution permission" means (emphasis added), "an identification of **what sharing activities are allowed on a derivative document**, such as open (no restrictions), non-commercial, and/or non-public, etc."

In the present Application, the customary meaning for the phrase "usage permission" is explicitly defined in the specification at paragraph 55. That definition must control examination of those claims that contain this phrase. Paragraph 55 states that the phrase "usage permission" means (emphasis added), "an identification of **what viewing and/or editing activities are allowed on a derivative document**. Examples of usage permissions can include read/write, read only, no access, and/or read/write with attribution, etc."

In the present Application, the customary meaning for the phrase "source document" is explicitly defined in the specification at paragraph 52. That definition must control examination of those claims that contain this phrase. Paragraph 52 states that the phrase "source document" means (emphasis added), a "**document that provides content that appears in derived documents**, that content not derived from another document."

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In the present Application, the customary meaning for the phrase “derived document” is explicitly defined in the specification at paragraph 26. That definition must control examination of those claims that contain this phrase. Paragraph 26 states that the phrase “derived document” means (emphasis added), “a document having content whose origin can be traced to a source document, perhaps through one or more intermediate derived documents.”

Thus, the phrases “distribution permission”, “usage permission”, “source document”, and “derived document” should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

V. The Anticipation Rejections

Each of claims 1-9, 12, 14-17, 19-20, 23-31, 33, 35, and 36 was rejected as anticipated, and thus unpatentable, under 35 U.S.C. 102(b). In support of the rejection, various portions of U.S. Patent Publication 20020107883 (“Schneid”) were applied. These rejections are respectfully traversed.

A. Legal Standards

To establish a *prima facie* case of express anticipation, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *See also*, MPEP 2131. The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”)

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The USPTO “has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967).

B. Analysis

1. Claim 1

Regarding the rejection of claim 1, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 1, from which each of claims 2-9, 12, 14-17, and 19-20 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of *Schneid* teach, “automatically and individually control a content, a plurality of content attributes, a usage permission, and a **distribution permission of each of a plurality of objects in each of multiple rendered documents derived from the source document**”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of *Schneid*. Yet the present Office Action fails to provide substantial evidence that this applied portion of *Schneid* teaches:

- i. any “distribution permission” whatsoever as Applicant has defined that phrase and distinguished that phrase from “usage permission”;
- ii. any permissions whatsoever of any “multiple rendered documents derived from the source document”;
- iii. an ability to “automatically and individually control” any “permission” “of each of a plurality of objects in each of multiple rendered documents derived from the source document”; or
- iv. consequently, “automatically and individually control a content, a plurality of content attributes, a usage permission, and a **distribution permission of each of a plurality of objects in each of multiple rendered documents derived from the source document**”.

For at least these reasons, it is respectfully submitted that the rejection of claim 1 is unsupported by *Schneid* and should be withdrawn. Also, the rejection of claims 2-9, 12, 14-17, and 19-20, each ultimately depending from independent claim 1, is unsupported by *Schneid* and also should be withdrawn.

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2. Claim 2

Regarding the rejection of claim 2, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 2 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “wherein said document management module is further adapted to define a content, a plurality of content attributes, a usage permission, and a **distribution permission** of each of the plurality of objects of the source document”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any “distribution permission” whatsoever as Applicant has defined that phrase and distinguished that phrase from “usage permission. Thus, no substantial evidence is of record that the applied portions of Schneid teach, “wherein said document management module is further adapted to define a content, a plurality of content attributes, a usage permission, and a **distribution permission** of each of the plurality of objects of the source document”.

For at least these reasons, it is respectfully submitted that the rejection of claim 2 is unsupported by Schneid and should be withdrawn.

3. Claim 3

Regarding the rejection of claim 3, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 3 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “wherein said document management module is further adapted to **prevent modification** of a content, a plurality of content attributes, a usage **permission**, and a **distribution permission** of each of the plurality of objects of the source document”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches an ability to “prevent modification” to any “permission”

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whatsoever. In addition, the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any "distribution permission" whatsoever as Applicant has defined that phrase and distinguished that phrase from "usage permission. Thus, no substantial evidence is of record that the applied portions of Schneid teach, "wherein said document management module is further adapted to **prevent modification** of a content, a plurality of content attributes, a usage permission, and a distribution permission of each of the plurality of objects of the source document".

For at least these reasons, it is respectfully submitted that the rejection of claim 3 is unsupported by Schneid and should be withdrawn.

4. Claim 8

Regarding the rejection of claim 8, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 8 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, "wherein said document management module is further adapted to **prevent modification** of a content, plurality of content attributes, usage **permission**, and distribution **permission** in each of the multiple documents derived from the source document".

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches an ability to "prevent modification" to any "permission" whatsoever. In addition, the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any "distribution permission" whatsoever as Applicant has defined that phrase and distinguished that phrase from "usage permission. Thus, no substantial evidence is of record that the applied portions of Schneid teach, "wherein said document management module is further adapted to prevent modification of a content, plurality of content attributes, usage permission, and distribution permission in each of the multiple documents derived from the source document".

For at least these reasons, it is respectfully submitted that the rejection of claim 8 is unsupported by Schneid and should be withdrawn.

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5. Claim 12

Regarding the rejection of claim 12, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 12 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “wherein said document management module is further adapted to language-independently search the database”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0035 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any “search” of any “database” whatsoever. Thus, no substantial evidence is of record that the applied portions of Schneid teach, “wherein said document management module is further adapted to language-independently search the database”.

For at least these reasons, it is respectfully submitted that the rejection of claim 12 is unsupported by Schneid and should be withdrawn.

6. Claim 14

Regarding the rejection of claim 14, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 14 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “wherein each of the plurality of objects of the multiple documents is stored only once in said database”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0030 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any “plurality of objects” that is “stored only once” in any “database” whatsoever. Thus, no substantial evidence is of record that the applied portions of Schneid teach, “wherein each of the plurality of objects of the multiple documents is stored only once in said database”.

For at least these reasons, it is respectfully submitted that the rejection of claim 14 is unsupported by Schneid and should be withdrawn.

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7. Claim 23

Regarding the rejection of claim 23, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 23, from which each of claims 24-31, 33, and 35 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “automatically and individually controlling a content, a plurality of content attributes, a usage permission, and a **distribution permission of each of a plurality of objects in each of multiple documents derived from the source document**”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches:

- i. any “distribution permission” whatsoever as Applicant has defined that phrase and distinguished that phrase from “usage permission”;
- ii. any permissions whatsoever of any “multiple rendered documents derived from the source document”;
- iii. an ability to “automatically and individually control” any “permission” “of each of a plurality of objects in each of multiple rendered documents derived from the source document”; or
- iv. consequently, “automatically and individually controlling a content, a plurality of content attributes, a usage permission, and a distribution permission of each of a plurality of objects in each of multiple documents derived from the source document”.

For at least these reasons, it is respectfully submitted that the rejection of claim 23 is unsupported by Schneid and should be withdrawn. Also, the rejection of claims 24-31, 33, and 35, each ultimately depending from independent claim 23, is unsupported by Schneid and also should be withdrawn.

8. Claim 24

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Regarding the rejection of claim 24, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 24 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “defining a content, a plurality of content attributes, a usage permission, and a **distribution permission** of each of the plurality of objects of the source document”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any “distribution permission” whatsoever as Applicant has defined that phrase and distinguished that phrase from “usage permission. Thus, no substantial evidence is of record that the applied portions of Schneid teach, “defining a content, a plurality of content attributes, a usage permission, and a distribution permission of each of the plurality of objects of the source document”.

For at least these reasons, it is respectfully submitted that the rejection of claim 24 is unsupported by Schneid and should be withdrawn.

9. Claim 25

Regarding the rejection of claim 25, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 25 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “**preventing modification** of a content, a plurality of content attributes, a usage **permission**, and a **distribution permission** of each of the plurality of objects of the source document”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches an ability for “preventing modification” to any “permission” whatsoever. In addition, the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any “distribution permission” whatsoever as Applicant has defined that phrase and distinguished that phrase from “usage permission. Thus, no substantial evidence is of record that the applied portions of Schneid teach, “preventing modification of a

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content, a plurality of content attributes, a usage permission, and a distribution permission of each of the plurality of objects of the source document”.

For at least these reasons, it is respectfully submitted that the rejection of claim 25 is unsupported by Schneid and should be withdrawn.

10. Claim 30

Regarding the rejection of claim 30, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 30 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “**preventing modification** of a content, plurality of content attributes, usage **permission**, and distribution **permission** in each of the multiple documents derived from the source document”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches an ability for “preventing modification” to any “permission” whatsoever. In addition, the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any “distribution permission” whatsoever as Applicant has defined that phrase and distinguished that phrase from “usage permission. Thus, no substantial evidence is of record that the applied portions of Schneid teach, “preventing modification of a content, plurality of content attributes, usage permission, and distribution permission in each of the multiple documents derived from the source document”.

For at least these reasons, it is respectfully submitted that the rejection of claim 30 is unsupported by Schneid and should be withdrawn.

11. Claim 33

Regarding the rejection of claim 33, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 33 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “**searching** across the source document and each document derived from the source document”.

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The present Office Action alleges that this claimed subject matter is taught by paragraph 0035 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any "searching" of any "document" whatsoever. Thus, no substantial evidence is of record that the applied portions of Schneid teach, "searching across the source document and each document derived from the source document".

For at least these reasons, it is respectfully submitted that the rejection of claim 33 is unsupported by Schneid and should be withdrawn.

12. Claim 35

Regarding the rejection of claim 35, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 35 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, "wherein each of the plurality of objects of the multiple documents is stored only once in said database".

The present Office Action alleges that this claimed subject matter is taught by paragraph 0030 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches any "plurality of objects" that is "stored only once" in any "database" whatsoever. Thus, no substantial evidence is of record that the applied portions of Schneid teach, "wherein each of the plurality of objects of the multiple documents is stored only once in said database".

For at least these reasons, it is respectfully submitted that the rejection of claim 35 is unsupported by Schneid and should be withdrawn.

13. Claim 36

Regarding the rejection of claim 36, the present Office Action fails to present substantial evidence, that is, evidence that is sufficient to support a *prima facie* rejection.

Specifically, claim 36 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, "automatically and individually control a content, a plurality of content attributes, a usage permission, and a **distribution permission of each of a**

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plurality of objects in each of multiple rendered documents derived from the source document”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches:

- i. any “distribution permission” whatsoever as Applicant has defined that phrase and distinguished that phrase from “usage permission”;
- ii. any permissions whatsoever of any “multiple rendered documents derived from the source document”;
- iii. an ability to “automatically and individually control” any “permission” “of each of a plurality of objects in each of multiple rendered documents derived from the source document”; or
- iv. consequently, “automatically and individually control a content, a plurality of content attributes, a usage permission, and **a distribution permission of each of a plurality of objects in each of multiple rendered documents derived from the source document”.**

For at least these reasons, it is respectfully submitted that the rejection of claim 36 is unsupported by Schneid and should be withdrawn.

VI. The Obviousness Rejections

Each of claims 10, 11, 13, 18, 21, 22, 32, and 34 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent Publication 20020107883 (“Schneid”), U.S. Patent Publication 20040216033 (“Hallett”), U.S. Patent 5,491,760 (“Withgottetal”), and/or U.S. Patent Publication 20020188841 (“Jones”). Each of these rejections is respectfully traversed.

A. Legal Standards

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

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1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). In *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007), the United States Supreme Court clarified that:

1. "[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art";
2. "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art";
3. it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit"; and
4. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

To establish a *prima facie* case of obviousness, certain criteria must be met. Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). That evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. In addition, the prior art reference (or references when combined) must

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teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

B. Analysis**1. Claims 10, 11, 13, 18, 21, and 22**

As indicated, *supra*, claim 1, from which each of claims 10, 11, 13, 18, 21, and 22 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of *Schneid* teach, "automatically and individually control a content, a plurality of content attributes, a usage permission, and a **distribution permission of each of a plurality of objects in each of multiple rendered documents derived from the source document**".

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of *Schneid*. Yet the present Office Action fails to provide substantial evidence that this applied portion of *Schneid* teaches:

- i. any "distribution permission" whatsoever as Applicant has defined that phrase and distinguished that phrase from "usage permission";
- ii. any permissions whatsoever of any "multiple rendered documents derived from the source document";

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- iii. an ability to “automatically and individually control” any “permission” “of each of a plurality of objects in each of multiple rendered documents derived from the source document”; or
- iv. consequently, “automatically and individually control a content, a plurality of content attributes, a usage permission, and a **distribution permission of each of a plurality of objects in each of multiple rendered documents derived from the source document**”.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness.

For at least these reasons, it is respectfully submitted that the rejection of claims 10, 11, 13, 18, 21, and 22, each ultimately depending from independent claim 1, is unsupported by the applied portions of the relied-upon references and should be withdrawn.

2. Claims 32 and 34

As indicated, *supra*, claim 23, from which each of claims 32 and 34 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Schneid teach, “automatically and individually controlling a content, a plurality of content attributes, a usage permission, and a **distribution permission of each of a plurality of objects in each of multiple documents derived from the source document**”.

The present Office Action alleges that this claimed subject matter is taught by paragraph 0041 of Schneid. Yet the present Office Action fails to provide substantial evidence that this applied portion of Schneid teaches:

- i. any “distribution permission” whatsoever as Applicant has defined that phrase and distinguished that phrase from “usage permission”;

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- ii. any permissions whatsoever of any "multiple rendered documents derived from the source document";
- iii. an ability to "automatically and individually control" any "permission" "of each of a plurality of objects in each of multiple rendered documents derived from the source document"; or
- iv. consequently, "automatically and individually controlling a content, a plurality of content attributes, a usage permission, and a distribution permission of each of a plurality of objects in each of multiple documents derived from the source document".

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness.

For at least these reasons, it is respectfully submitted that the rejection of claims 32 and 34 each ultimately depending from independent claim 1, is unsupported by the applied portions of the relied-upon references and should be withdrawn.

VII. New Claims

1. Claim 37

Claim 37 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the computer-based document management module is adapted to allow a user to search for a topic across all of the multiple documents and the source document regardless of differences in language between the multiple documents and the source document". For at least this reason, a Notice of Allowance regarding claim 37 is respectfully requested.

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2. Claim 38

Claim 38 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “wherein the computer-based document management module is adapted to allow enforcement of instructions provided by an owner of the source document regarding legal use of the source document, the computer-based document management module adapted to allow security properties to be modified to a more restrictive setting in each of the multiple documents”. For at least this reason, a Notice of Allowance regarding claim 38 is respectfully requested.

3. Claim 39

Claim 39 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “wherein the computer-based document management module is adapted to allow enforcement of instructions provided by an owner of the source document regarding legal use of the source document, the computer-based document management module adapted to provide future users with contact information of the owner entered by the owner for each of the plurality of objects of the source documents”. For at least this reason, a Notice of Allowance regarding claim 39 is respectfully requested.

4. Claim 40

Claim 40 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “wherein the computer-based document management module is adapted to, responsive to publication of the source document, lock all of the plurality of objects of the source document, the computer-based document management module adapted to allow an owner of the source document to edit objects in each of the multiple documents after the source document has been published”. For at least this reason, a Notice of Allowance regarding claim 40 is respectfully requested.

5. Claim 41

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Claim 41 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the computer-based document management module is adapted to, responsive to a selection by an owner of the source document, remove all rights of the owner regarding the source document but retain all original credits at an edition or object level of the source document". For at least this reason, a Notice of Allowance regarding claim 41 is respectfully requested.

6. Claim 42

Claim 42 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the computer-based document management module is adapted to, responsive to a selection by an owner of the source document, enforce a right of the owner to require a user to include and retain contents of the source document in each of the multiple documents, the computer-based document management module adapted to allow the user to append additional objects into each of the multiple documents". For at least this reason, a Notice of Allowance regarding claim 42 is respectfully requested.

7. Claim 43

Claim 43 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the computer-based document management module is adapted to, responsive to a search by a user, perform a database query associated with the search, responsive to a determination that the database query has returned data, the computer-based document management module adapted to perform an Edition query that uses a Shell relationship to identify all other Editions in a Shell of the Editions returned in the database query". For at least this reason, a Notice of Allowance regarding claim 43 is respectfully requested.

8. Claim 44

Claim 44 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the database contains a table that links a

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content identifier to an identifier of a container object of the source document". For at least this reason, a Notice of Allowance regarding claim 44 is respectfully requested.

VIII. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

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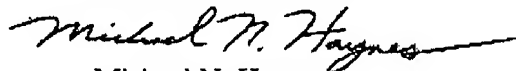
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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